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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/365,426	08/02/1999	PETER HARTMAIER	51410-P013US	1765

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DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.  
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EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/365,426

Applicant(s)

HARTMAIER, PETER

Examiner

Daniel S Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 11-15,23,27-32 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 15,23 and 34-40 is/are allowed.
- 6) ☐ Claim(s) 11-14,27 and 28 is/are rejected.
- 7) ☐ Claim(s) 29-32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1. Receipt of the amendment filed September 9, 2003 is acknowledged. Claims 11-15, 23, 27-32 and 34-40 are pending in the application, claims 15, 23, and 34-40 are allowed and 11-14, 27 and 28 are rejected, and 29-32 are objected to.

### ***Response to Arguments***

Applicant's arguments filed September 9, 2003 have been fully considered but they are not persuasive. The 35 USC 103 (a) rejection(s) of 11-14, 27 and 28 is maintained. It is respectfully submitted that applicant fails to appreciate or recognize the level of ordinary skill in the art, The alleged omission of particular details with regard to claims 11, 27 and 28 was in fact addressed in the previous office action mailed June 5, 2003 wherein it discussed the deficiencies of the Taskett reference T237 and how it would have been modified by the subsequent references. It is respectfully asked to read the action again. Furthermore, in response to applicant's arguments it is submitted that the test for obviousness under 35 USC 103 is what the combined teachings of applied references, when taken as a whole, would have suggested to one of ordinary skill in the art which were provided to the applicant in the previous action(s). (see *In re Keller*, 642, F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re McLaughlin*, 443 F. 2d, 1392, 170 USPQ 209 (CCPA 1971).

Again, references are evaluated by what they suggest one of ordinary skill in the art, rather their specific disclosure (see *In re Bozek*, 163, USPQ 545 (CCPA 1969)).

In this case the primary reference shows a method of providing prepaid account services to consumers comprising the steps of:

assigning prepaid accounts to said consumers (see T237, *issuing a transaction card with an a unique authorization account code 142-- see fig 2, Abstract and page 7, line 17 to at least page 8, line 2*),

communicating with a service provider network/host computer regarding consumer replenishment transactions (see T237, fig. 6, block 620--*recharge account* and block 610--*prompt selection from menu*, also at least page 15, lines 5-6) .

wherein said communicating with the network step further comprises the steps of:

receiving transaction messages following individual replenishment transactions by said consumers; and sending a message indicating the disbursement of funds associated with said replenishment transactions(610--*prompt selection from menu--- next appropriate action...* indicates that the replenishment transaction has been made, also at least page 15, lines 5-6), communicating with a prepaid engine regarding said consumer replenishment transactions (see T237, fig. 7, Block 710--*prompt caller to recharge account*). The secondary reference, T579 discloses receiving a reconciliation message summarizing individual transactions that occurred during a certain period, and reconciling said individual transactions.

**Reason from previous action provided for combination of T237 and T579:**

it would have been an obvious extension to the T237 teaching of checking the account balance of an calling card/transaction card, and/or regenerating a calling card/phone card account from the user menu options. The transaction summary data

would provide the consumer with an obvious alternative method of checking the account balance or regeneration transaction by visually reviewing any kind of transaction data/history stored by the host computer/service provider network. Thus such a modification would be an obvious expedient to one of ordinary skill in the art.

T237 also fails to disclose, as in claims 11, 13 and 14, communicating with a service banking network/host computer regarding consumer replenishment transactions.

T579 teaches an Automated Teller Machine as a device in which to use the prepaid instrument/prepaid transaction card (see page 6, line 1+).

**Reason from previous action provided for combination of T237 and T579 again:**

It would have been obvious for an artisan at the time of the invention would recognize that the ATM/financial network would be a alternative source for financial data retrieval and replenishment, being an art recognized equivalent to the T237 service provider network, inasmuch as financial data can be stored and retrieved from both devices. Thus such a modification would have been an obvious matter of design choice to one of ordinary skill in the art.

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T237 also fails to disclose associating said prepaid accounts with wireless telephones.

This feature is found in Kawan (see figs. 2C and fig. 4, col. 4, lines 4-14; and col. 6, lines 4+).

**Reason from previous action provided for combination of T237 and Kawan:**

T237 and T579 are associated with prepaid phone card accounts, it would have been obvious for an artisan of ordinary skill at the time of the inventions to T237 and T579 to substitute the association of the wireless prepaid phone card account for the normal phone card account such a modification/substitution would be considered one of art recognized equivalence and thus an obvious expedient to one of ordinary skill in the art.

Re claim language 11:

T237 also fails to disclose sending a disbursement message to the banking network, wherein the disbursement message network regarding the distribution of funds associated with the replenishment transactions.

Pitroda discloses a universal electronic transaction card which may transmit transaction information over financial and other networks (see Pitroda, col. 7, ll. 10 to col. 8, ll. 17; and col. 10, ll. 53+).

**Reason from previous action provided for combination of T237 and**

**Pitroda:**

Since both T237 are associated with prepaid phone card accounts, it would have been obvious for an artisan of ordinary skill at the time of the inventions to T237 and T579 to substitute the UET card for the normal phone card because an artisan at the time of the invention would have recognized the convenience and versatility of the UET to provide the user with various transaction means in one. Thus a user would have sought to use such a card in the system as T237, having the ability to perform a diversity of relating functions. Thus such a substitution would be an obvious expedient well within the ordinary skill in the art. (Pitroda reads on applicant's claim 11, Imitation, col. 3, ll. 4-33)

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5771, or the examiner's supervisor **Vincent Millin** whose telephone number is (703) 308-1065.

Response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

for formal communications intended for entry, or (703) 305-7687, for informal or draft communications, please label AProposed@ or ADraft@. Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to *[daniel.felten@uspto.gov]*.

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All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1 195 OG 89.



**DSF**

November 13, 2003



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